

Appl. No.: 10/759,481

Amdt. dated: 02/16/2007

Reply to Office action of: 09/18/2006

### REMARKS / ARGUMENTS

In the Office action of September 18, 2006 claims 3 and 10 were objected to and claims 1-9 were rejected. The applicants acknowledge that claim 10 is objected to as based on rejected base claim 1 but would be allowable if rewritten in independent form. The applicants request amendment of claim 1 as indicated above and continued examination. The applicants submit that claim 1, as amended, as well as claim 10, is allowable.

Claim 3 stands objected to because the claim includes the phrase "capable of." The applicants submit that functional language does not, in and of itself, render a claim improper and that a functional limitation must be evaluated and considered, just like any other limitation in a claim (MPEP 2173.05(g)). However, to advance the prosecution of the application the applicants request amendment of the claim as indicated above. As amended, the claim does not include the phrase in question and the applicants request withdrawal of the objection.

Claims 1-9 stand rejected under 35 U.S.C. 103(a) as unpatentable over Palkuti, U.S. Patent No. 4,575,676 (Palkuti). According to the office action, Palkuti discloses a probe station comprising a first platen (31) supporting an electrical probe (47); a chuck (41) supporting a device under test (25); a second platen (21) supporting an optical probe for testing optical components, for examples, photodiodes and phototransistors, formed on the DUT; the second platen being positioned above the device under test and having a top surface with at least 70% terminating in free space when the optical probe (33) is not supported thereon. Further, the office action asserts that while Palkuti does not disclose the first platen being positioned above the second platen it would be obvious to interchange the positions of the platens. The applicants respectfully submit that to be obvious there must some suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art to modify the reference or combine the reference teachings, there must be a reasonable expectation of success, and the prior art must teach or suggest all of the claim limitations. (MPEP2143). The applicants submit that, as stated office action, Palkuti does not disclose or suggest that a platen that supports an electrical probe be positioned above a platen that supports an optical probe and suggests no motivation for such an arrangement. Moreover, the applicants respectfully submit that it is not reasonable to expect that the positions of the probe

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card 31 and the auxiliary shield 21 of Palkuti are interchangeable because it would not be reasonable to expect that the probes can be extended through the shield and collimator into contact with the DUT without substantially jeopardizing the effectiveness of the shield and collimator in limiting the cross section of the radiation beam to a single device (col. 4, line(s) 55-60). Further, the applicants respectfully submit that the auxiliary collimator is not supported on the top surface of the auxiliary shield and is not arranged to emit or detect light on an axis that is not normal to the surface of the DUT that is contacted by the probes as recited in the amended claim. The applicants respectfully submit that, as amended, claim 1 is not obvious from Palkuti because Palkuti does not teach or suggest all of the claim limitations, does not suggest or provide a motivation for the modification suggested by the office action and can not be reasonably be expected to succeed without undue experimentation. The applicants request withdrawal of the rejection.

With regard to claims 2 - 9, the applicants submit that the claims are dependent from claim 1 and inherit all of the limitations of claim 1. Since claim 1 is not obvious from Palkuti for the reasons stated above, the applicants submit that claims 2 - 9 are not obvious from Palkuti. Further, with regard to claim 3, the applicants submit that Palkuti discloses that the auxiliary shield 21 is supported on the probe card 31 by spacers 35 (col. 3, line(s) 1-4) and that Palkuti does not disclose or suggest that the auxiliary shield is movable relative to the probe card or provide any motivation for such a modification of the disclosed device. Moreover, the applicants respectfully submit that FIGS. 1-3 of Palkuti are elevation views and disclose only a single dimension of the top surface. Therefore, the applicants submit that a conclusion about the relative sizes of the surface areas can not be drawn from FIGS. 1-3 and, more particularly, three contradictory conclusions about the relative sizes of the surface areas, as asserted in the office action, cannot not be drawn from the figures. The applicants request withdrawal of the rejection of claims 2-9.

The applicants request amendment of the specification to update the reference to related applications.

This amendment is submitted with a request for continued examination and a request for extension of time and the applicants provisionally petition for an additional extension of time, if necessary. The applicants assert that no additional claim fees are due. However, the

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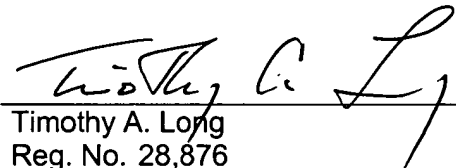
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Commissioner is hereby authorized to charge any required additional fee for any additional extension of time or additional claims to the Deposit Account referred to in the enclosed petition for extension of time.

The applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes that for any reason direct contact with applicants' attorney would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,  
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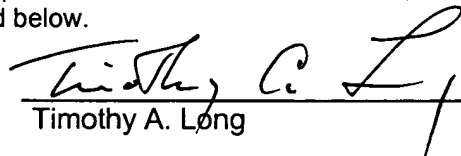
By:

  
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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Dated: 02/16/2007

  
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Timothy A. Long